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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/658,321

09/10/2003

Chikara Yamamoto

P23803

1870

7055

7590

08/10/2005

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EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/658,321

**Applicant(s)**

YAMAMOTO, CHIKARA

**Examiner**

Jordan M. Schwartz

**Art Unit**

2873

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-17 is/are allowed.
- 6) ☒ Claim(s) 18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 19, that part of the claim stating, "said upper portion visibly changes..." renders the claim vague and indefinite. Specifically, if the upper portion is changing, then this change is inherently "visible" and it is not clear what this is adding as a limitation rendering the claim vague and indefinite. Furthermore, if applicant intended to mean "visible to the wearer", the claim is still vague and indefinite. Specifically, whether a change would be visible to the wearer would depend on the quality of the eyesight of the wearer. One with very good eyesight would be able to notice very slight changes in power while one with poor eyesight would only notice very large changes in power. If a certain amount of power change (such as 1 diopter by way of example) was intended as a limitation then it needs to be claimed with greater clarity and particularity.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Baudart et al patent number 6,318,859.

Baudart et al'859 reads on these claims by disclosing the limitations therein including the following: a spectacle lens (column 1, lines 6-24) comprising a middle portion located at a middle section and configured for a middle vision with average transmission power within the middle portion being substantially constant (Figures 19 and 22, with the central portion has a substantially constant power and claim 1 re for middle vision); an upper portion with an average transmission power continuously changing from a lower end of the upper portion to a top end of the spectacle (Figures 19 and 22 such as in Figure 19 from about from  $X=10$  to the top of the lens the power is continuously changing); a lower portion with an average transmission power continuously changing from a top end of the lower portion to a lower end of the spectacle (Figures 19 and 22 such as Figure 19 from about  $X=0$  to the bottom of the lens the power is continuously changing); satisfaction of the condition of claim 18 (Figure 19 with  $W$  of approximately 10 mm); the upper transmission power in the upper portion visibly changing (to the extent this term is understood i.e. Figure 19). Furthermore, if the intended meaning is "visible to the wearer", the change in Baudart would inherently be "visible to the wearer" in the case of a wearer having good eyesight and therefore able to detect minor changes in power.

#### ***Prior Art Citations***

Baudart et al patent number 6,382,789 cited in the prior office action would have read on claims 18-19, however, such rejections would have been repetitive.

#### ***Allowable Subject Matter***

Claims 1 and 3-17 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with reference to independent claims 1 and 16, none of the prior art either alone or in combination disclose or teach of the claimed spectacle lens, specifically including, as the distinguishing feature in combination with the other limitations, the claimed clear vision area whose horizontal size is configured to be the greatest in the central portion. Specifically, with reference to independent claim 17, none of the prior art either alone or in combination disclose or teach of the claimed spectacle lens, specifically including, as the distinguishing feature in combination with the other limitations, the claimed average transmission power continuously decreasing and increasing as claimed.

### ***Response to Arguments***

Applicant's arguments filed May 31, 2005 have been fully considered but, with respect to the Baudart'859 reference and claims 18-19 they are not persuasive. Specifically, applicant argues that the change in power in the upper portion of Baudart'859 is 0.3 diopters and is therefore numerically insignificant to the point that such a change is not noticeable to the wearer. However, the independent claim 18 does not claim an amount of change of the optical power i.e. whether it is numerically significant or not, nor does claim 18 have any limitation as to whether such a change is noticeable to the wearer. Claim 18 is merely claiming "said upper portion is changing continuously from a lower end of said upper portion to a top end of said spectacle lens".

This limitation is disclosed in Baudart'859 as set forth in the rejection above. With respect to claim 19, the change in power of Baudart'859 is a "visible change" as set forth in the rejection above. Furthermore, if the intended meaning is "visible to the wearer", the change in Baudart would inherently be "visible to the wearer" in the case of a wearer having good eyesight and therefore able to detect minor changes in power.

For applicant's information, in claim 18, claiming, "the upper portion changing continuously by at least 1 diopter from a lower end of said upper portion to a top end of said spectacle lens" would overcome the Baudart'859 reference and the cited Baudart'789 reference, however, applicant is now after final and such change may require additional searching.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is (571) 272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (571) 272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jordan M. Schwartz  
Primary Examiner  
Art Unit 2873  
August 8, 2005